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OCT 01 2008

**OFFICE OF PETITIONS**

In re Application of  
Gingras, et al.  
Application No. 10/021,509  
Filed: December 7, 2001

: CLARIFICATION OF  
: POWER OF  
: ATTORNEY  
:

The instant application has been forwarded by the Board of Patent Appeals and Interferences to the Office of Patent Legal Administration for clarification of the power of attorney.

There is no current valid power of attorney of record. All previous filed attempts to convey a power of attorney or act as an assignee are accepted for the sole purpose of supporting previous correspondence to and from the Office.

The current correspondence address is that of the first named inventor, Marie-Claude Gingras. All future submissions must be signed by both inventors, unless based on an appropriate power of attorney of record, or the submitter is acting in a representative capacity.

**BACKGROUND**

1. The instant application was filed December 7, 2001. The transmittal paper that accompanied the application directed correspondence to the address associated with Customer Number 26271 and was signed by Melissa Acosta, an attorney at Fulbright & Jaworski, LLP. The application was published on September 12, 2002 as Application Publication US20020128444A1.
2. On February 22, 2002, a Notice to File Missing Parts was mailed which required, *inter alia*, a signed oath or declaration, pursuant to § 1.63.
3. On March 11, 2002, a response to the Notice to File Missing Parts was filed. An executed § 1.63 declaration was submitted naming as the inventors: Marie-Claude Gingras and Judith F. Margolin, and referred to the title of the invention as 'TREM-1 SPLICE VARIANT (Trem-1SV) AND OTHER NATURAL AND ARTIFICIAL TREM 1 SEQUENCE VARIANTS FOR USE IN MODIFYING IMMUNE/INFLAMMATORY RESPONSES.' Form PTO/SB/81 (Power of Attorney or Authorization of Agent) accompanied the response and was signed by W.

Dalton Tomkin. Power of attorney was apparently to be given by assignee Baylor College of Medicine<sup>1</sup> to the practitioners associated with Customer Number 26271.<sup>2</sup>

4. On March 11, 2002, an Assignment Recordation Cover Sheet, \$40 recordation fee, and an assignment document, apparently in support of the March 11, 2002 power of attorney were filed for recordation in the assignment data base but not in the application file. The assignment document identifies inventors Judith F. Margolin and Marie-Claude Gingras as the assignors and Baylor College of Medicine as the assignee. The assignment was executed on March 6, 2002 and identified the title of the invention being assigned as 'TREM-1 SPLICE VARIANT AND OTHER NATURAL AND ARTIFICIAL TREM 1 SEQUENCE VARIANTS FOR USE IN MODIFYING IMMUNE/INFLAMMATORY RESPONSES.'<sup>3</sup>

5. On March 21, 2002, the Office recorded the assignment documents filed March 11, 2002, at Reel 012689, Frame 0272.

6. On July 17, 2006, an Assignment Recordation Cover Sheet, \$40 recordation fee, and an assignment document were filed. The assignment document identifies inventors Judith F. Margolin and Marie-Claude Gingras as the assignors and GenePrint Corporation as the assignee. The Office recorded the assignment documents the same day at Reel 017950, Frame 0645.

7. On February 20, 2007, a "Power of Attorney and Correspondence Address Indication Form and Statement Under 37 CFR 3.73(b)," and a copy of the assignment document recorded on July 17, 2006 were filed.<sup>4</sup> Power of attorney was to be given to practitioners associated with Customer Number 22850, and was signed by the CEO of GenePrint Corporation, Eugene Roussel. The assignment to GenePrint Corporation was by the inventors, identified the application as 10/021,509 filed on December 2, 1001. The assignment was executed on March 1, 2006.<sup>5</sup>

8. On May 18, 2007, a Notice revoking power of attorney was mailed to the address associated with Customer Number 26271 (Fulbright & Jaworski, LLP), and a Notice of acceptance of power of attorney<sup>6</sup> was mailed to the address associated with Customer Number 22850 (Oblon, Spivak, McClelland, Maier, & Neustadt, P.C.).

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<sup>1</sup> The name of the assignee was present in the signature box.

<sup>2</sup> The Power of Attorney was improper: (1) because 3.73(b) was not complied with. Although the box "I am the Assignee of record of the entire interest. See 37 CFR 3.71. *Statement under 37 CFR 3.73(b) is enclosed.* (Form PTO/SB/96)" was checked, the statement establishing the correct assignee was not received by the Office, and (2) the form that was received granting power of attorney from alleged assignee Baylor College of Medicine was signed by an individual who was not established as having the authority to act on behalf of the assignee (no statement of authorization or appropriate title were provided).

<sup>3</sup> The invention title in the assignment differs from the invention title in the § 1.63 by the absence of the parenthetical material.

<sup>4</sup> The documents were not properly indexed in the patent application Image File Wrapper and as a result were not recognized by the Office.

<sup>5</sup> On April 24, 2007, a copy of the February 20, 2007 paper was filed.

<sup>6</sup> Although the Office accepted the power of attorney, the document did not comply with 37 CFR 3.73(b)(1)(i) since it was not "accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11."

9. On December 4, 2007, a "Petition for Attorney Withdrawal Under 37 CFR 1.36" was filed. The petition was signed by C. Irvin McClelland on behalf of all attorneys of record, namely, all the attorneys/agents associated with Customer Number 22850.<sup>7</sup> The Petition requested that all further correspondence be forwarded to the Assignee identified as GenePrint Corporation.

10. On December 31, 2007, a Notice Regarding Change of Power of Attorney was mailed. The Notice stated that the December 4, 2007 withdrawal of attorney had been accepted and the new correspondence address would be the "new address of record."

11. On December 31, 2007, Form PTO/SB/82 (Revocation of Power of Attorney With New Power of Attorney and Change of Correspondence Address) was filed. The form was signed by Eugene Roussel, CEO of GenePrint Corporation and attempted to: (1) appoint practitioners associated with the Customer Number 76171<sup>8</sup> based on the submission of a copy an assignment from the inventors,<sup>9</sup> and (2) change the correspondence address to that of Customer Number 76171.<sup>10</sup>

12. On January 7, 2008, a Decision on Petition to Withdraw From Record was mailed, notwithstanding the December 31, 2007 Notice (item 10). The Decision stated that the December 4, 2007 request to withdraw was approved and that all future correspondence would be directed to first-named inventor Marie-Claude Gingras as "there is no attorney of record at this time."

13. On January 15, 2008, the Office processed the PTO/SB/82 and changed the correspondence address to the address associated with Customer Number 76171.

14. On March 4, 2008, a Notice Regarding Power of Attorney was mailed to GenePrint Corporation. The Notice stated that the December 31, 2007 Power of Attorney was not accepted because the person appointed in the Power of Attorney is not registered to practice before the U.S. Patent and Trademark Office.<sup>11</sup>

15. On April 9, 2008, a Notice of Acceptance of Power of Attorney was mailed to GenePrint Corporation in reply to the December 31, 2007 Power of Attorney (item 11) notwithstanding the March 4, 2008 Notice not accepting the Power.

16. On April 29, 2008, an Assignment Recordation Cover Sheet, and a confirmatory license in compliance with Executive Order 9424 were filed were filed in the assignment data base but not the application. The confirmatory license identifies Baylor College of Medicine as the assignor and the National Institutes of Health (NIH), U.S. Dept. of Health and Human Services (DHHS),

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Such statement is required irrespective of the actual submission of the assignment for recording on July 17, 2006.

<sup>7</sup> On December 5, 2007 a copy of the December 4, 2007 petition was filed.

<sup>8</sup> The Power of Attorney was improper as there are no patent practitioners associated with Customer Number 76171.

<sup>9</sup> The assignment is discussed at item 6.

<sup>10</sup> A Customer Number may be used to set the correspondence address independent of appointment of a power of attorney. MPEP 403.

<sup>11</sup> The Power of Attorney was not compliant. See Footnote 6.

U.S. Government as the assignee. The Office recorded the assignment documents the same day at Reel 020869, Frame 0568.

17. A May 14, 2008 Petition for Rehearing of a March 31, 2008 Decision by the Board of Appeals and Patent Interferences affirming the examiner is pending.

### **Power of Attorney**

In view of the multiple attempts to change the power of attorney and the technical defects of those attempts, and the multiple Office papers granting and denying power of attorney, clarification of the file record is appropriate.

The inventors have assigned their rights in the invention twice, once to Baylor College of Medicine and later to GenePrint. Baylor College of Medicine has executed a license to NIH.

Based on the assignment of rights by the inventors, power of attorney has attempted to be given to practitioners associated with Customer Numbers: 26,271 (Fulbright, & Jaworski, LLP), 22850 (Oblon, Spivak, McClelland, Maier & Nuestadt, P.C.), and 76171 (having no identified practitioners, but is apparently associated with the correspondence address of the CEO of GenePrint).

Based on the convoluted history of the power of attorney, the minor nature of power of attorney defects regarding regulatory requirements, the advanced stage of prosecution, and the lack of any contest regarding power of attorney in the record file, the Office will accept the previous filed powers of attorney and attempts to act as an assignee, but only so far as to support previous correspondence to and from the Office.

Accordingly, the instant Clarification, and a response to the rehearing request will be directed to the first named inventor. All future correspondence by the Office will also be directed towards the first named inventor unless a new compliant power of attorney is submitted. Consequently, any future reply by applicant must be signed by the two inventors, unless a new compliant power of attorney is submitted to support a reply by some other party, or a party is acting in a representative capacity.

Due to the convoluted history of the power of attorney and multiple assignments by the inventors, a courtesy copy of the instant clarification will also be mailed to prior parties seeking to establish a power of attorney, except for the practitioners associated with Customer Number 22850 (as they withdrew). Notwithstanding the lack of a power of attorney associated with Customer Number 76171, the Clarification will be sent to its associated address. The decision to the rehearing request will be sent to the current correspondence address, which is the first named inventor.

Parties seeking to submit a new power of attorney should understand that:

(1) The recording of an Assignment is merely an administrative act and does not represent a determination by the Office of the validity of the assignment or the effect of the document has on the title to an application or patent. MPEP 317.03.

(2) The Office will not resolve ownership disputes, which resolution are dependent upon state law and appropriate for resolution in a state court. MPEP 324, IX. Conflicting 37 CFR 3.73(b) Statements.

## **PROCESSING**

1. The application will be returned to the Board of Patent Appeals and Interferences for processing after mailing of this decision.
2. Telephone inquiries related to the instant Clarification may be directed to the undersigned at (571) 272-7709 or Terry Dey, Technical Writer/Editor, Office of Patent Legal Administration, at (571) 272-7730.



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